REMARKS

The Office Action mailed December 15, 2006 considered claims 1-31, 35 and 36. Claims 1-7, 11-18, 21-29, 31 and 35-36, were rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al. (US 2002/0194307) hereinafter *Anderson* in view of Oppenheimer et al. (US 2003/0014477) hereinafter *Oppenheimer,* in view of Eldridge et al. (US 6,397,261) hereinafter *Eldridge.* Claims 8, 9, 10, 19, 20 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Anderson* in view of *Oppenheimer* in view of *Eldridge* and further in view of LaRue et al. (US 6,535,892) hereinafter *LaRue.*[1]

As a preliminary matter, Applicant's would like to thank the Examiner for the courtesies extended during the telephonic interview held on January 16, 2007.

By this paper, no claims have been amended and new claims 37-39 have been added[2] such that claims 1-22 and 35-39 remain pending in the application of which claims 1, 11, 21, 35 and 38 are the only independent claims.

Claims 1 and 21 are method claims, which claim embodiments of applicants' invention from a client-side perspective. Claims 11 and 35 are computer program product claims which correspond to method claims 1 and 21 respectively. New claim 38 is an embodiment performed from a server side perspective.

The independent claims from the client side perspective are directed to conserving network bandwidth while still providing a transparent experience for a user by displaying an indication that a document is attached to an email message, sending a document inclusion instruction to a server without the document itself which allows the server to attach the document to a message if the document is available at the server or allowing the client to determine whether or not to send the document to the server if the document is not at the server. Claim 38 from the server side perspective is similar in that a server receives a document inclusion instruction and attaches an identified to a message if the document is available at the server. If

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[1] Although the prior art status of the cited art is not being challenged at this time, Applicant reserves the right to challenge the prior art status of the cited art at any appropriate time, should it arise. Accordingly, any arguments and amendments made herein should not be construed as acquiescing to any prior art status of the cited art.

[2] Support for the added claims can be found throughout the specification, but with particularity at paragraphs [0042]-[0044].

the document is not available at the server, the server determines if a different version of the document may be used in completing the document inclusion instruction.

As discussed during the telephonic interview, claim 1, 11, 21, and 35 have not been amended as art showing each element of the claims has not been cited. For example, each of these claims recites that "the client thereafter determining whether or not to send the document to the server." To show this element, the office action states "Oppenheimer does not explicitly state that the client determines whether to send the document to the server, rather merely states that the file is downloaded from the client...one of ordinary skill in the art would find this feature obvious in order to conserve bandwidth on the users network, thereby allowing more control over what the computer does and how it utilizes bandwidth...." However, there is no reference to any art suggesting both this element and the stated motivation to combine it with Oppenheimer. In fact, the statements in the Office Action appear to be a direct admission that this element has not been shown in the art cited by the Office Action.

Further illustrating the usefulness and non-obvious nature of this element is newly added claim 37. Claim 37 recites "if the identified document is not already stored at the server, the client then indicating to the server that a different version of the document stored at the server is acceptable, whereupon the server executes the document inclusion instruction using the different version of the document." Thus, the client can specifically determine *not* to send the identified document, but rather to instruct the server to use a different version of the identified document already at the server. Thus, the element recited in claims 1, 11, 21 and 35 is not simply an automatic upload operation when a document is not at the server, but rather a determination processes that determines whether or not a document needs to be uploaded even when the document is not at the server. During the telephonic interview, the Examiner seemed to agree, that at least insofar as claim 37 is concerned, the art cited in the office action does not teach or suggest the use of different versions.

With regard to claim 38, claim 38 is patentable for at least reasons cited for claim 37. In particular, claim 38 recites: "if the identified document is not already stored at the server, then determining if a different version of the identified document stored at the server may be used in completing the document inclusion instruction" and "if the different version of the identified document may be used in completing the document inclusion instruction, the server thereafter completing the document-inclusion instruction using the different version of the identified
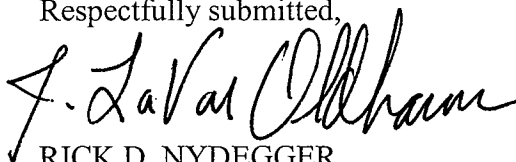
document." As noted previously, the art cited in the office action does not disclose the ability to use a different version of a document to complete a document inclusion instruction.

In view of the foregoing, Applicant respectfully submits that the other rejections to the claims are now moot and do not, therefore, need to be addressed individually at this time. It will be appreciated, however, that this should not be construed as Applicant acquiescing to any of the purported teachings or assertions made in the last action regarding the cited art or the pending application, including any official notice. Instead, Applicant reserves the right to challenge any of the purported teachings or assertions made in the last action at any appropriate time in the future, should the need arise. Furthermore, to the extent that the Examiner has relied on any Official Notice, explicitly or implicitly, Applicant specifically requests that the Examiner provide references supporting the teachings officially noticed, as well as the required motivation or suggestion to combine the relied upon notice with the other art of record.

In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney at 801-533-9800.

Dated this 30th day of January, 2007.

Respectfully submitted,

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